

REMARKS

Claims 1-8, 11-22, 24-72, 75-120, 122, and 124-127 are pending in the application, of which Claims 1, 13, 20, 27, 46, 58, 65, 77, 82, 85, 100, 106, and 113-118 are independent claims.

The Applicant notes with appreciation the allowance of Claims 13-19, 77-81, and 114 and that Claims 52 and 103 would be allowed if written in independent form. In preparation for issuance, certain allowed claims have been amended to clarify the claim limitations.

The Office Action finally rejects Claims 1-8, 11-12, 20-22, 24-51, 53-72, 75-76, 82-102, 104-113, 115-120, 122, and 124-127. Claims 113-118 (including allowed Claim 114) stand rejected under 35 U.S.C. § 101; and Claims 1-12, 20-51, 53-72, 75, 82-85-102, 104-113, 115-122, 124-127 stand rejected under 35 U.S.C. § 103. While finality of the Office Action and the rejections are traversed, the rejected independent claims have been amended to recite allowed subject matter.

Regarding Finality of Office Action

As discussed below, various arguments made by the Applicant in traversing prior rejections were not answered in the current Office Action as specified by MPEP § 707.07(f). By making the Office Action final without answering the Applicant's traversals, the Office has not met its burdens and obligations.

In addition, the status of certain claims is unclear. For example, Claim 114 is both allowed and rejected. Furthermore, claims that depend from allowed independent claims stand rejected instead of being allowed.

As such, the Applicant believes that finality of the Office Action is premature and should be withdrawn.

Regarding Allowed Claims 13, 77, and 114

Independent Claims 13, 77, and 114 have been allowed. Upon reviewing the claims for issuance, however, inconsistent claims language was identified that could be problematic under

Section 112. As a result, Claims 13, 77, and 114 have been amended to clarify the claim limitations. It is believed that the amended claims limitations do not impact the reasons for allowing the claims.

Acceptance of the amendments and allowance of the amended claims are respectfully requested.

Regarding Rejections Under Section 101

Claims 113-118 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejections are traversed.

First, it is unclear how Claim 114 can be both allowed and rejected in the same Office Action. Clarification is requested.

Second, as previously argued, Claims 113-118 recite an article of manufacture comprising “a computer-usable medium” and “a set of computer instructions embodied on the medium”. The Office continues to merely assert that all limitations recite data, and then proceeds to state that data is not a process, machine, composition of matter, or manufacture. The Office still does not explain how “a computer-usable medium” can be considered data or how “a set of computer instruction embodied on the medium” can be considered data. In any event, as previously argued, article of manufacture claims drawn to a computer-usable medium are acceptable to the Office, as agreed in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

Despite the Applicant’s traversal of the rejections, the Office failed to address the above issues.

While Claims 113-118 were previously amended to clarify that the computer instructions are for operating a computer. The Examiner suggests using the particular wording of “computer instructions that cause a computer to” (Final Office Action (11/20/2009), ¶ 11.) Consequently, Claims 113-118 have amended using the exact words suggested by the Examiner in an effort to advance the claims to allowance and to reduce the issues for appeal. Those amendments, however, are not believed to alter the scope of the claims.

In addition, Claims 113-118 have been amended to incorporate allowed subject matter.

Entry of the amendments and reconsideration of the rejections under Section 101 are respectfully requested.

Regarding Rejections Under Section 103

Claims 1-12, 20-51, 53-72, 75, 82-85-102, 104-113, 115-122, 124-127 stand rejected under 35 U.S.C. § 103. The rejections are traversed. However, all claims have been amended to incorporate allowable subject matter.

Claims 1-12, 65-72, 75, 113, 119-122, and 124-125 stand rejected based on “Archive” (<http://web.archive.org/web/19980109140106/http://archive.org/>) in view of “Betterwhois.com” (<http://web.archive.org/web/19991127110345/http://betterwhois.com/>). The rejections are traversed, but the independent claims have been amended to recite allowed subject matter so as to expedite prosecution.

As noted in the Applicant’s previous remarks, it was believed that the stated rejections to Claims 119-112 were meant to be to Claims 119-122. Again, clarification is requested.

It is also noted that rejected Claims 120 and 125 depend from allowed Claim 13. Should Claims 120 and 125 thus be allowed and not rejected? Clarification is requested.

The Office asserts that Archive teaches “a searchable electronic index of original content having original content stored therein” (Final Office Action (11/20/2009), ¶ 15 (emphasis in original)). The Office expressly states that “file *content* is the same – the appearance/Frame SRC’s and name of files are changed for temporal integrity and cataloging purposes.” (*Id.* (emphasis in original)) However, the Office again failed to cite to any location in the Archive reference for those so-called teachings.

The Applicant previously traversed the representation of the Archive reference and presented evidence that the above statements were factually inaccurate. If it believed the Applicant was incorrect, the Office should have presenting contrary evidence. Instead, bald conclusions are set forth as factual statements in a final office action.

Regardless, independent Claims 1, 65, and 113 have now amended to recite allowed subject matter from Claims 13 and 77. The claims should now be in condition for allowance.

Claims 20-26, 82-85, and 115 were rejected based on “Betterwhois.com” in view of “Archive.org.” The rejections are traversed, but the independent claims have been amended to recite allowed subject matter so as to expedite prosecution.

It is assumed that by “Archive.org” the Office is referring to the “Archive” reference cited in prior rejections. If not, clarification is requested.

Independent Claims 20, 82, and 115 have now amended to recite allowed subject matter from allowed Claims 13 and 77. The claims should now be in condition for allowance.

Claims 27-45, 85-99, 116, and 126 were rejected based on U.S. Patent No. 6,271,840 to Fineth et al. in view of “Betterwhois.com.” The rejections are traversed, but the independent claims have been amended to recite allowed subject matter so as to expedite prosecution.

Independent Claims 27, 85, and 116 have now amended to recite the allowed subject matter of Claims 13 and 77. The claims should now be in condition for allowance.

Claims 46-51, 53-57, 100-102, 104-105, and 117 were rejected based on “Betterwhois.com” in view of “archive.org.” The rejections are traversed, but the independent claims have been amended to recite allowed subject matter so as to expedite prosecution.

It is assumed that by “archive.org” the Office is referring to the “Archive” reference cited in prior rejections. If not, clarification is requested.

Because the Examiner has concluded that Claims 52 and 103 recite allowable subject matter, independent Claims 46, 100, and 117 have been amended to recite those allowable limitations and Claims 51-52 and 103 have been canceled. Acceptance of the amendments and allowance of Claims 46-50, 53-57, 100-102, 104-105, and 117 is respectfully requested.

Claims 58-64, 106-112, 118, and 127 were rejected based on Finseth in view of “Betterwhois.com,” and further in view of “archive.org.” The rejections are traversed, but the

independent claims have been amended to recite allowed subject matter so as to expedite prosecution.

Again, it is assumed that by "archive.org" the Office is referring to the "Archive" reference cited in prior rejections. If not, clarification is requested.

Independent Claims 58, 106, and 118 have now amended to recite allowed subject matter from allowed Claims 13 and 77. The claims should now be in condition for allowance.

As discussed, all rejected independent claims have been amended to recite allowed subject matter and should therefore be in condition for allowance. Entry of the amendments should therefore be proper. Because the allowance of the dependent claims should follow from allowance of their independent claims, the dependent claims are also in condition for allowance. The dependent claims do, however, recite additional patentable subject matter.

Acceptance of the amendments and reconsideration of the rejections under Section 103 are respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this application, the Examiner is invited to contact the undersigned attorney.

Respectfully submitted,

R.D. Johnson & Associates, P.C.

By _____ /Rodney D. Johnson/

**Rodney D. Johnson
Registration No. 36,558**

Telephone: (781) 444-6844
Facsimile: (617) 412-3081

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